

DOCKET NO.: MQPP-0002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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#5
12/4/00
P11901

In re patent application of:

Blucher

Serial No.: 09/491,639

Group Art Unit: 3727

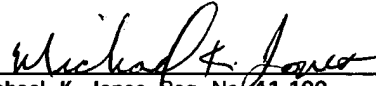
Filed: January 27, 2000

Examiner: S. Castellano

For: **CONTOUR FIT PAN LINER FOR A FOOD SERVICE PAN**

I, Michael K. Jones, Registration No. 41,100 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

On November 22, 2000


Michael K. Jones, Reg. No. 41,100

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO OFFICE ACTION

This responds to the restriction and election requirement dated October 23, 2000 (paper no. 4), issued in connection with the above-captioned patent application.

1. In the Office Action, restriction to one of the following inventions was required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a combination of a pan liner system, classified in class 220, subclass 495.11.
- II. Claims 13-19, drawn to a subcombination of a pan liner, classified in class 383, subclass unknown.



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III. Claims 20-27, drawn to a method of making a pan liner, classified in class 493, subclass unknown.

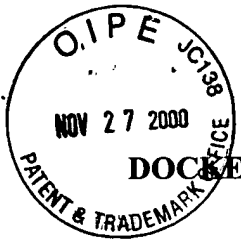
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The Examiner has imposed the restriction requirement on the following basis:

(1) That inventions III and (I and II) are related as process of making and product made. In the instant case, the Examiner alleges that the liner can be made by another method such as blow molding rather than folding and closing the bottom end wherein the liner wouldn't have any flat bottom edges, only contoured bottom edges.

(2) That inventions I and II are related as combination and subcombination. In the instant case, the Examiner alleges that the combination as claimed does not require the particulars of the subcombination as claimed because the combination isn't required to have a contoured bottom edge constructed to conform to the shape and size of the pan. In addition, the Examiner alleges in the Office Action that the subcombination has separate utility, such as use as a bag by itself, without the pan.

Applicants provisionally elect to prosecute the claims of Invention I (claims 1-12), however, this provisional election is made with traverse. Applicants first note that the "separate utility" to which the Examiner refers is not described in the instant specification. Moreover, even where a combination does not set forth the details of a subcombination that has separate utility, a restriction requirement is only proper "if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search." MPEP §806.05(c). In this case, because the details of Invention II (claims 13-19) are similarly recited in Invention I (claims 1-12), Applicants respectfully submit that the field of search required for examination of both groups of claims is likely to be the same. MPEP §806.05(c)(A). It is respectfully submitted that the search and examination of invention I and invention II can be made without serious burden, and accordingly, Applicants submit that there may be no need for restriction in this case with respect to the inventions I and II. Therefore, reconsideration of the restriction requirement is respectfully requested.



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2. The Office Action also alleges that the application contains claims directed to the following patentably distinct species of the claimed invention:

Group A: Fig. 8A;

Group B: Fig. 9; and

Group C: Fig. 10.

The Office Action states that Applicants are required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Office Action indicates that currently claim 1 appears to be generic.

Applicants provisionally elect to prosecute the species of Group A, which Applicants believe are readable on claims 1-5, 8-16, 19-23, and 25-27. Upon allowance of a generic claim, Applicants request consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim, as provided for by 37 CFR 1.141.

Respectfully submitted,

Michael K. Jones

Registration No. 41,100

Date: **November 22, 2000**

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